

REMARKS

Claims 11-16 are pending in the above-referenced application.

Claims 11-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,887,269 to Brunts et al. ("Bruns") in view of U.S. Patent No. 5,884,218 to Nimura et al. ("Nimura"). Applicant respectfully submits that the rejection should be withdrawn for the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, but the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness.

Independent claim 11 recites, in relevant parts, a navigation card for use with a key card reader of a radio receiver of a navigation system, which navigation card includes: "a memory in which at least one navigation destination is stored"; "audio data assigned to the at least one navigation destination stored in the memory"; and "wherein the navigation card is insertable into, and read by, the key card reader of the radio receiver, the key card reader normally adapted to read a key card to establish the operational readiness of the radio receiver." Independent claims 13 and 16 recites substantially similar features as the above-recited features of claim 11.

In support of the rejection, the Examiner contends that while "Nimura et al. do not disclose that audio data assigned to the at least one navigation destination stored in the memory, . . . the memory card, as set forth in column 8, lines 41-50, actually stores audio data and navigation destination," and "therefore Nimura et al. inherently disclose 'audio data assigned to the at least one navigation destination stored in the memory.'" Applicant

respectfully notes that the Examiner's "inherent disclosure" conclusion does not make any sense, particularly in light of the Examiner's own statement that "Nimura et al. do not disclose that audio data assigned to the at least one navigation destination stored in the memory." Furthermore, not only is the Examiner misinterpreting the claim by completely ignoring the definition and the context provided by the Specification in connection with the claimed limitation, but the actual disclosure of Nimura fails to support the Examiner's conclusion.

Initially, as exhaustively explained throughout the prosecution of the present application, the meaning of "audio data assigned to the at least one navigation destination stored in the memory" is beyond debate: it means audio data describing the characteristics of the navigation destination, i.e., "information relating to points of interest . . . , such as museums, historical city districts and other tourist sights" (Substitute Spec., p. 4, l. 27-28), and the "audio file is invoked and played as soon as the [vehicle] has reached a tourist sight that was previously entered as a navigation destination." (Substitute Spec., p. 5, l. 13-15). The Examiner, however, simply fails to address the proper scope of the claimed feature "audio data assigned to the at least one navigation destination stored in the memory." With respect to the issue of claim interpretation, the applicable rules are clear: a) "the inventor's written description of the invention, for example, is relevant and controlling insofar as it provides clear lexicography or disavowal of the ordinary meaning" (C. R. Bard Inc. v. United States Surgical Corp., 73 U.S.P.Q.2d 1011, 1014 (Fed. Cir. 2004)); b) "Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage" (MPEP 2111); and c) the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach (MPEP 2111).

With respect to the Examiner's "inherent disclosure" argument, there is absolutely no logical reason why the IC memory card of Nimura inherently associates the destination data and the audio data. To the extent the Examiner is arguing that simply storing the audio data and the destination data on the same IC memory card inherently results in assigning the audio data to the destination data, Applicant notes that this argument is completely illogical and contrary to the established rules for determining "inherent disclosure." In order to rely on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the **allegedly inherent characteristics**

necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). “The fact that certain result or **characteristic may occur or be present in the prior art is not sufficient to establish the inherency** of that result or characteristic.” (M.P.E.P. § 2112, citing In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993)). There is simply no reason why alleged destination data would necessarily have to be always assigned to the alleged voice guidance data of Nimura.

Independent of the above, even if one assumed for the sake of argument that some motivation existed to combine the teachings of Brunts and Nimura (with which assumption Applicant does not agree), the combination still would not teach or suggest the claimed feature of “the navigation card is insertable into, and read by, the key card reader of the radio receiver, the key card reader normally adapted to read a key card to establish the operational readiness of the radio receiver.” There is absolutely no teaching or suggestion in either Brunts or Nimura that the navigation card is inserted into a key card reader of the radio receiver that is “adapted to read a key card to establish the operational readiness of the radio receiver.” To the extent the Examiner argues that this claimed feature is an intended use or field of use which does not patentably distinguish the claimed structure, this contention is simply incorrect: the claimed feature is not merely an intended use or field of use, and the fact that the claimed feature is a functional limitation does not render the feature patentably meaningless, and “the functional limitation must be evaluated and considered.” MPEP 2173.05(g). Applicant further notes that the section of MPEP cited by the Examiner, i.e., § 2114, deals with functional recitation in **claim preambles**, unlike the present case.

Independent of the above, with respect to the Examiner’s alleged motivation for combining the teachings of Brunts and Nimura, Applicant notes that the overall teachings of Brunts and Nimura simply do not support the combination. First, with respect to the Examiner’s contention that Brunts teaches that “the memory card stores data regarding a navigation destination,” Applicant notes that column 7, lines 1-10 of Brunts merely discloses that the memory card contains an information directory for a given geographic area. Furthermore, to the extent the Examiner argues that the “second reference to Nimura et al. has been provided to overcome the missing feature from Brunts et al.,” and “[f]or that reason the combination of Brunts et al. and Nimura et al. would be proper and therefore addresses the claimed limitation of the present invention,” Applicant notes that this rationale is

completely insufficient for establishing obviousness. Essentially, the Examiner's rationale for combining the specific teachings of Brunts with the selected teachings of Nimura is that Nimura discloses the claimed feature that is missing in Brunts. However, this is not a valid "motivation" for combining the teachings, but merely that the combination can be made. In this regard, it is well-established law that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01 (citing In re Mills, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)).


Independent of the above, Applicant notes that claim 11 recites that the navigation card includes "a memory in which at least one navigation destination is stored . . . ; and audio data assigned to the at least one navigation destination stored in the memory," which means the audio data and the at least one navigation destination are both stored on the same navigation card. Neither Brunts nor Nimura teaches or suggests that the audio data and the at least one navigation destination are both stored on the same navigation card, so a combination of Brunts and Nimura would fail to teach or suggest that the audio data and the at least one navigation destination are both stored on the same navigation card.

For at least these reasons, it is submitted that the overall teachings of Brunts and Nimura do not render obvious the subject matter of independent claim 11 and its dependent claim 12. Since independent claims 13 and 16 recite features analogous to those of independent claim 11, it is submitted that claims 13 and 16, as well as their dependent claims 14 and 15, are likewise allowable over Brunts and Nimura.

CONCLUSION

It is respectfully submitted that all pending claims of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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